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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/316,546	05/21/1999	JAY S. WALKER	WD2-99-012	7943

22927 7590 12/16/2004

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EXAMINER

KARMIS, STEFANOS

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/316,546

Applicant(s)

WALKER ET AL.

Examiner

Stefano Karmis

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[Handwritten signature]

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following communication is in response to Applicant's amendment filed 13 August 2003.

Status of Claims

2. Claims 25, 40, 51, 56 and 57 are currently amended. Claims 1-24, 26-39, 41-50, 52-55 and 58 are left as originally filed. Therefore claims 1-58 are under prosecution in this application.

Summary of this Office Action

3. Applicant's arguments, filed 13 August 2004, with respect to the rejection(s) of claim(s) 1-58 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made as discussed below.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-58 are rejected under 35 U.S.C. 101 as non-statutory. The method claims as presented do not claim a technological basis in the preamble or the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the body of the claim structural / functional interrelationship which can only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) - used only for content and reasoning since not precedential].

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4, 6-16, 21-44, 49-54 and 56-58 are rejected under 35 U.S.C. 102(e) as being anticipated by Herman et al. (hereinafter Herman) U.S. Patent 6,341,353.

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Regarding independent claims 1, Herman discloses a method for providing an offer during a transaction between a merchant and a customer comprising:

receiving a request for authorization of a purchase amount, the purchase amount to be paid from a financial account of the customer (column 22, lines 8-65 and column 43, lines 9-25);

determining an offer based upon the received request (column 44, lines 33-44);

transmitting an authorization of the purchase amount (column 22, lines 8-65 and column 43, lines 9-25);

transmitting the offer for output to the customer on a record of charge (column 44, lines 5-20)

receiving an acceptance of the offer by the customer on the record of charge (column 47, lines 15-19 and Figure 24, step 2404); and

providing a benefit to the customer after receiving the acceptance (column 47, lines 8-19).

Claim 2, the offer defines an obligation for the customer to fulfill in exchange for the benefit (column 47, lines 8-19).

Claim 3, the benefit comprises a supplemental product, and in which the obligation comprises an additional payment to be provided by the customer in exchange for the supplemental product (column 42, lines 65-67 and column 47, lines 8-19).

Claim 4, the benefit comprises a discount (column 44, lines 9-12).

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Regarding independent claim 6, Herman discloses a method for providing an offer during a transaction between a merchant and a customer comprising:

receiving a request for authorization of a purchase amount, the purchase amount to be paid from a financial account of the customer (column 22, lines 8-65 and column 43, lines 9-25);

determining an offer based upon the received request (column 44, lines 33-44);

transmitting an authorization of the purchase amount (column 22, lines 8-65 and column 43, lines 9-25);

transmitting the offer for output to the customer on a record of charge (column 44, lines 5-20); and

providing a benefit to the customer after receiving the acceptance (column 47, lines 8-19).

Claim 7, receiving an acceptance of the offer by the customer on the record of charge (column 47, lines 15-19 and Figure 24, step 2404).

Claim 8, adjusting an available credit limit of the financial account based on the received acceptance (column 22, lines 23-41).

Claim 9, providing a discount on the purchase amount (column 44, lines 9-12).

Claim 10, providing a reward of alternate currency after the acceptance (column 25, line 49 thru column 26, line 25).

Claim 11, determining whether the financial account is in good standing; and transmitting the authorization from the transaction if the financial account is in good standing (column 23, lines 5-29).

Claims 12 and 13, determining whether an available balance of the financial account is at least zero (column 6, line 65 thru column 7, line 6).

Claim 14, determining whether a financial account is in good standing and transmitting an offer for output to the customer on a record of charge if the financial account is in good standing (column 6, line 65 thru column 7, line 6 and column 23, lines 5-29).

Claims 15 and 16, determining whether an available balance of the financial account is at least zero (column 6, line 65 thru column 7, line 6).

Claim 21-24, the offer is determined based on a product identifier of a product purchased during the transaction, merchant identifier, purchase amount, or supplemental product (column 44, lines 30-44).

Claim 25, providing a discount on the purchase amount after the customer accepts the offer for a service (column 44, lines 8-12 and column 47, lines 8-19).

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Claim 26, the offer comprises a requirement that the customer use the service for a predetermined time (column 22, lines 42-65).

Claim 27, wherein the service includes at least one of long distance telephone service, Internet service, banking services, credit card account services, insurance services, securities trading services, satellite television services and cable television services (column 4, lines 7-14).

Claim 28, providing a discount to the customer after the customer accepts the offer (column 44, lines 8-12 and column 47, lines 8-19).

Claim 29, providing the customer with a coupon after an acceptance of the offer (column 39, lines 34-41 and column 47, lines 8-19).

Claim 30, wherein the offer comprises a plurality of offers (column 42, lines 65-67 and Figure 21).

Claim 31, the customer accepts at least one of the offers (column 47, lines 8-19 and Figure 24).

Claim 32, the record of charge includes at least one signature line, each of the at least one signature line being associated with one of the purchase amount and the offer (column 6, lines 55-63 and column 22, lines 23-41).

Claim 33, adjusting a balance of a financial account of the merchant if the customer accepts the offer (column 22, lines 23-41).

Claims 34-37, the financial account is a credit card or debit card and the offer is based on credit history (column 20, lines 33-39).

Claims 38 and 40, determining whether an available balance of the debit account is at least equal to the purchase amount and providing authorization (column 23, lines 5-28).

Claims 40-43, reconciling a merchant account after receiving a record of charge, debiting the financial account by the purchase amount, crediting a merchant account after receiving an acceptance by the customer and transmitting a code to the merchant corresponding to the offer (column 22, lines 50-65 and column 47, line 8-9).

Regarding independent claim 44, Herman discloses a method for providing an offer during a transaction between a merchant and a customer comprising:

Receiving an indication of a financial account to be charged for a purchase amount corresponding to a transaction (column 20, lines 33-39);

transmitting a request for authorization of a purchase amount, the purchase amount to be paid from a financial account of the customer (column 22, lines 8-65 and column 43, lines 9-25);

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receiving an authorization of the purchase amount (column 22, lines 8-65 and column 43, lines 9-25);and

providing a benefit to the customer after receiving the acceptance (column 47, lines 8-19).

Claim 49, the record of charge includes at least one signature line, each of the at least one signature line being associated with one of the purchase amount and the offer (column 6, lines 55-63 and column 22, lines 23-41).

Claim 50, adjusting a balance of a financial account of the merchant if the customer accepts the offer (column 22, lines 23-41).

Regarding independent claim 51, Herman discloses a method for providing an offer during a transaction between a merchant and a customer comprising:

registering an offer with a financial institution, the offer to be presented to a customer during a transaction with a merchant, the offer specifying a product (column 42, lines 65-67 and column 43, lines 60-67);

receiving an indication of a financial account to be charged for a purchase amount corresponding to a transaction (column 20, lines 33-39); and

providing the product to the customer (column 47, lines 8-19).

Claim 52, wherein the product is a service (column 4, lines 7-14).

Claim 53, offering a discount in exchange for accepting the offer (column 44, lines 5-12 and column 47, lines 8-19).

Claim 54, wherein the service includes at least one of long distance telephone service, Internet service, banking services, credit card account services, insurance services, securities trading services, satellite television services and cable television services (column 4, lines 7-14).

Regarding independent claim 56, Herman discloses a method for accepting an offer comprising;

initiating a transaction with a merchant column 22, lines 18-41);

providing to the merchant, an identifier of a financial account to charge a purchase amount of the transaction (column 22, lines 18-65);

receiving from the merchant a record of charge for the transaction, the record of charge including the purchase amount, and the record of charge including an indication of an offer (column 44, lines 15-21 and Figure 21).

Claim 57, providing acceptance of the offer on the record of charge (column 47, lines 8-19 and Figure 27).

Claim 58, receiving an adjustment of a balance of the financial account based on the acceptance (column 47, lines 8-19 and Figure 27).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 5, 17-20, 45-48 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herman et al. (hereinafter Herman) in view of Tadesco et al. (hereinafter Tadesco) U.S. Patent 6,161,059.

Claims 5, 17-20 and 45-48, Herman teaches providing an offer during a transaction between a merchant and a customer. Herman fails to teach that the obligation necessary to obtain the offered benefit is participation in a survey. Tadesco teaches a vending machine

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method and apparatus for encouraging participation in a marketing effort, in which, customers are encouraged to participate in a survey and rewarding those customers with a discount on a subsequent purchase, rebate or a supplementary product (Abstract). Tadesco further teaches survey questions related to the merchant as well as sales pitches (column 7, lines 35-42). It would have been obvious at the time of the Applicant's invention to modify the teachings of Herman to include the teachings of Tadesco because it provides another efficient parameter to satisfy for offering an incentive during a customer to merchant transaction.

Claim 55, Herman teaches signature authentication for transactions between a customer and merchant. Herman fails to specify that separate signatures are required for the transaction as well as the offer. Official Notice is taken that providing signatures to approve transactions between two parties is old and well known in the financial arts. Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Herman to include separate signatures because it provides approval for all parts of a transaction in an efficient manner.

Response to Arguments

11. Applicant's arguments with respect to claim 1-58 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (703) 305-8130. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully Submitted
Stefano Karmis
03 December 2004



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SUPERVISORY PATENT EXAMINER
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